

Notification of Non-Compliant Appeal Brief (37 CFR 41.37)	Application No. 08/720,070	Applicant(s) HYATT, RICHARD G	
	Examiner Suzanne Dino Barrett	Art Unit 3676	

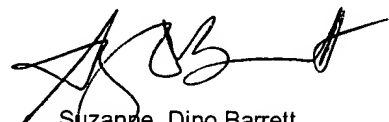
--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 20 April 2005 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file a complete new brief in compliance with 37 CFR 41.37 within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.**

1. ☐ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☒ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☒ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☒ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☐ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☐ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☒ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☒ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☒ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☒ Other (including any explanation in support of the above items):

see attachment.


 Suzanne Dino Barrett
 Primary Examiner
 Art Unit: 3676

DEFECTIVE BRIEF NOTICE

Initially, it is noted that the amendments filed 10/25/04, previously indicated as being entered upon appeal, are not entered pursuant Rule 41.33(b) as set forth below. Accordingly, the amendment filed 4/20/05, simultaneously with this brief, is also not entered. Consequently, the claims previously cancelled (85-89,101-104) must be reinstated and the typos and 112 problems corrected by the amendment of 10/25/04 must now be addressed in Appellant's brief where indicated. In addition, it is noted that since the amendment to claim 6 deleted a "means" limitation, and since that "means" language is now reinstated, it must be clearly and specifically discussed in the Summary of the Claimed Invention as indicated in the rule excerpt set forth in paragraph 4(b) of the accompanying Notification of Non-Compliant Appeal Brief (form ptol-462).

Renege on entry of after-final amendments filed on or after Sept. 13, 2004 as outside the scope of examiner's authority – See 41.33(b)

41.33(b) Amendments filed on or after the date of filing a brief pursuant to Sec. 41.37 may be admitted: (1) To cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or (2) To rewrite dependent claims into independent form.

(c) All other amendments filed after the date of filing an appeal pursuant to Sec. 41.31(a)(1) through (a)(3) will not be admitted except as permitted by Secs. 41.39(b)(1), 41.50(a)(2)(i), 41.50(b)(1) and 41.50(c).

The Brief is defective under 41.37(a)(2)

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See Sec. 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and Sec. 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.

This is in response to the appeal brief filed 4/20/05. The appeal brief is defective for the following reasons:

1. *Grouping of the Claims*

This section is no longer required under new rules and should be deleted.

Heading Grouping of the Claims was required by former Rule 192(c)(7) and is removed from 41.37. See 69 Fed. Reg. 49959, 49962

(9) The grouping of claims requirement set forth in former Rule 192(c)(7) is removed. The general purpose served by former Rule 192(c)(7) is addressed in Sec. 41.37(c)(1)(viii). The existing grouping of claims requirement has led to many problems such as (i) Grouping of claims across multiple rejections (e.g., claims 1-9 rejected under 35 U.S.C. 102 over A while claims 10-15 are rejected under 35 U.S.C. 103 over A and the appellant states that claims 1-15 are grouped together); (ii) Claims being grouped together but argued separately (e.g., claims 1-9 rejected under 35 U.S.C. Sec. 102 over A, the appellant groups claims 1-9 together but then argues the patentability of claims 1 and 5 separately); and (iii) examiners disagreeing with the appellant's grouping of claims.

2. *Status of Claims*

The statement of the status of the claims contained in the brief is incorrect.

Since the amendments filed 10/25/04 and 4/20/05 will not be entered for purposes of appeal, the reference to claims 85-89,101-104 should be reinstated in the brief and the appendix and the previously amended claims 1,6,11,14,56,70,75,120 should be reinstated to their pre-amendment form. Therefore, the status of the claims would be as follows: Claims 1-56,64-116,119-121 are pending. Claims 25-33,39-42,55,78-84,107 are allowed. Claims 53,71,72,74,86,87,110 are objected to as dependent upon a rejected claim. Claims 1-24,34-38,46-52,54,56,64-70,75-77,85,88-106,108,109,111-116,119-121 are rejected. Claims 43-45,73,94 are withdrawn from consideration. Claims 57-63,117,118 have been cancelled.

3. Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendments after final filed 10/25/04 and 4/20/05 will not be entered for purposes of appeal. Although the amendment filed 10/25 had previously been indicated as entered upon appeal, this is contrary to Rule 41.33(b) as discussed above. Thus the status of the amendments should read that the amendments filed 10/25/04 and 4/20/05 have not been entered.

4. Summary of the Claimed Invention

Deficiencies under 41.37(c)

I.

41.37(c)(1) (v) Summary of claimed subject matter. (a) A concise explanation of the subject matter defined in **each of the independent claims** involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. ...

(1) Appellant has provided only a general statement of the claimed invention.

(2) See Comment 53 of **69 Fed. Reg. 49959**.

Comment 53: One comment expresses concern in regard to the requirement of proposed Sec. 41.37(c)(1)(v) that a concise explanation of the subject matter defined in each of the independent claims involved in the appeal be provided. Specifically the comment asks what is a concise statement, what is required, does the explanation have to show how each claim is different, does the requirement apply to all drawings and embodiments, or only a representative drawing? The comment states that the Office deleted a similar requirement in 1992 relating to documents submitted in an IDS because "concise explanation" descriptions rarely communicated any useful information, improved the quality of patent examination but provided an opportunity to attack the

patent on the grounds of inequitable conduct. The comment suggests that the requirement be clarified or dropped.

Answer: **A patentability determination must be performed on a claim- by-claim basis.** The first step in a patentability determination is to **construe a given claim and determine its metes and bounds.** "Analysis begins with a key legal question - what is the invention claimed?" since "[c]laim interpretation * * * will normally control the remainder of the decisional process." *Panduit Corp. v. Dennison Manufacturing Co.*, 810 F.2d 1561, 1567-68, 1 USPQ2d 1593, 1597 (Fed. Cir.), cert. denied, 481 U.S. 1052 (1987). The existing provisions of 37 CFR Sec. 1.192(c)(5) (2003) are directed to providing a summary of the "invention," not the claims. See *In re Hiniker Co.*, 47 USPQ2d 1523 (Fed. Cir. 1998): "The invention disclosed in Hiniker's written description may be outstanding in its field, but the name of the game is the claim. See Giles Sutherland Rich, *Extent of Protection and Interpretation of Claims - American Perspectives*, 21 *Int'l Rev. Indus. Prop.*" By statute, the Board reviews "adverse decisions of examiners upon applications for patents." 35 U.S.C. 6(b). **For the Board to reach an informed decision on the merits of a rejection presented for review, the record should reflect the respective positions of the examiner and appellant as to the scope of the claims. It is the experience of the Board that the prosecution and examination in a significant number of appeals forwarded for decision on appeal has taken place in the context of "applicant's invention," not on a claim-by-claim basis. Thus, the Board is oftentimes confronted with a record in which no significant claim construction has occurred. Those records are not susceptible to meaningful review and result in an inordinate number of remands.**

The determination of how "concise" the explanation must be will need to be determined on a case-by-case basis. If the prosecution and examination has been based upon a discussion of the patentability of individual claims instead of the "invention," it is expected the explanation will be more "concise" than if the prosecution and examination has been conducted on the basis of the "invention." As to what is required, the proposed rule states that reference to the specification by page and line number, and to the drawing, if any, by reference characters is required. Appellant may include any other information of record which will aid the Board in considering the subject matter of each independent claim. The explanation does not have to show how each claim is different. **The purpose of the requirement is to aid the Board in considering the subject matter of the independent claims so that an informed review of the examiner's adverse determination of patentability can be made. Whether the explanation is limited to a single drawing or embodiment or is extended to all drawings and embodiments is a decision appellant will need to make.** The proposed concise explanation of the subject matter defined in each independent claim is different from a concise explanation of a reference. It is the applicant who is responsible for drafting claims and choosing the language and terms used to define the claimed invention. 35 U.S.C. 112(2)

("The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.") **As the originator of the claim language, applicant should know what is intended by the various words and phrases used to define the claimed subject matter and thus, providing a concise explanation of the subject matter of each independent claim as proposed should not be an undue burden.** This is in contrast to explaining the possible relevance of a document that may not have originated from applicant. **Another difference is that the number of independent claims presented for review in an appeal is a matter directly within appellant's control,** while appellant does not have control over the number of documents that should be cited to the Office.

The subject matter of each independent claim needs to be concisely explained for a number of reasons. For example, if the Board decides that a rejection is to be reversed for a given independent claim, the remaining independent claims must be reviewed to determine if the reasons for reversing the rejection of the first independent claim apply to the remaining independent claims. Furthermore, if appellant chooses to argue a group of claims which includes more than one independent claim, the Board will need to review, at the least, each independent claim to determine which claim will be selected as representative of the group. Apart from reviewing the examiner's adverse decision on patentability, the Board may also make new grounds of rejection pursuant to former Sec. 1.196(b) (2003) or make an explicit statement that a claim would be allowable if amended under former Sec. 1.196(c) (2003). The concise explanation of the subject matter of each independent claim will aid the Board in making these determinations. 69 Fed. Reg. 49959, 49976.

II.

41.37(c)(1) (v) Summary of claimed subject matter. (b) (1) identify, for each independent claim involved in the appeal and for each independent claim argued separately, **every means plus function and step plus function** under 35 USC 112, sixth paragraph, and/or (2) **set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters.**

(1) Accordingly, since the "means" language of claim 6 (previously deleted in the amendment of 10/25/04, which is now not entered) is reinstated, this "means" limitation must be identified and discussed pursuant the rule set forth above.

6. Argument Notes:

(1) 41.37(c)(1)(vii) is not defective but appellant groups some claims with rejections that do not apply to such claims.

Claims 14 (allowed but rejected under 35 USC 112) and 43 (withdrawn) are argued under the prior art grounds of rejection on pages 31-33; claims 65 and 75 are argued with respect to the prior art rejections on pages 41-47, when both claims are only rejected under double patenting.

(2) The appellant has failed to address or argue the grounds of rejection under 35 USC 112, 2nd paragraph with respect to claims 14 and 121. Accordingly, it is unclear if appellant is acquiescing to these rejections.

(3) In addition, appellant has presented 18 pages of conclusory arguments wherein some claims are further specifically addressed. It is unclear why these arguments pertaining to specific claims are not presented in the pertinent individual claim argument subsections throughout the brief.

7. Claim Appendix

The brief does not contain a correct copy of the appealed claims as an appendix thereto. (37 CFR 41.37(c)(1)(viii)).

41.37(c)(1)(viii) is defective since appellant provided two copies. Only one correct copy should be provided.

Furthermore, Appellant should carefully revise his appendix to reinstate the previously entered amended claims 1,6,11,14,56,70,75,120 to their pre-amendment form in the appendix.

8. Evidence Appendix

The brief does not contain copies of any evidence submitted. If no evidence has been submitted, "none" should be typed on that appendix page.

9. Related Proceedings Appendix

The brief does not contain copies of any decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto. If no related proceedings exist, "none" should be typed on that appendix page.

41.37(c)(1)(ix) & (x) are missing. See comment 60, 69 Fed. Reg. 49959, 49978.

Comment 60: One comment requests clarification as to **whether appendixes as required by Secs. 41.37(c)(ix-x) are necessary at all when no evidence or related proceedings exist, or whether an appendix must be included with the indication "none."**

Answer: Sections 41.37(c)(ix-x) require the appeal to contain an evidence appendix and a related proceedings appendix. **If no evidence or related proceedings exist, an evidence appendix should be included with the indication "none" and a related proceedings appendix should be included with the indication "none."** In addition, a brief containing a Table of Contents indicating that no evidence appendix is part of the brief or that no related proceedings appendix is part of the brief would be acceptable under the Rule since it would clearly indicate that no evidence is being relied upon by the appellant in the appeal or that no related proceedings having decisions rendered by a court or the Board exist.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suzanne Dino Barrett whose telephone number is 571-272-7053. The examiner can normally be reached on M-Th 8:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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sdb